

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patentee : Marcus A. Horwitz, *et al.*

Serial No. : 10/595,385

Filed : April 13, 2006

Patent No. : 7,622,107

Art Unit : 1645

Examiner : Albert Mark Navarro

Confirm. No.: 8534

Customer No.: 45200

Issued : November 24, 2009

Title : RECOMBINANT INTRACELLULAR PATHOGEN IMMUNOGENIC COMPOSITIONS AND METHODS FOR USE

MAIL STOP OFFICE OF PETITIONS / OPLA

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
PURSUANT TO 37 CFR § 1.705(D)

Dear Sir:

Patentee hereby petitions for reconsideration and correction of the classification of the above-referenced patent from Patent Term Extension (PTE) status, to Patent Term Adjustment (PTA) status. This application was filed April 13, 2006, and issued November 24, 2009, meeting PTA qualifications. Newly established calculations under Patent Term Adjustment are respectfully requested.

In consideration of the Office's inadvertent oversight, and requested correction, patentee asserts that under Patent Term Adjustment (PTA), the calculations are projected to accord this patent a Total PTA of 335 days from a Total PTE of -0- days.

STATEMENT OF THE FACTS and REVIEW OF FILE HISTORY

35 U.S.C. §154(b)(1)(A) establishes that a patent's term is to be extended for each day that the PTO fails to meet particular deadlines. Such deadlines include issuance of a first Office Action within fourteen months, and responding to a reply within four months. Patentee respectfully submits that the Office failed to meet these deadlines in the instant application. The first Office Action for the instant application was mailed by the Office on

June 12, 2008. This is more than 14 months after the National Stage Entry and 371 filing date, with no missing requirements, and thus the commencement date of the application, April 13, 2006 (International Filing date October 15, 2004). This is a **PTO delay of 365 days** beyond the 14-month due date.

On January 29, 2009, the Office timely mailed a *Final Rejection* action. Applicant responded with a timely *Amendment After Final* on March 30, 2009, and received an *Advisory Action* dated April 29, 2009. Responsive to this action, Applicant subsequently filed a *Request for Continued Examination (RCE)* on May 29, 2009. This is a **APPL delay of 30 days beyond the 3-month due date**.

In applying Patent Term Adjustment calculations to this patent, the results may present an APPL delay of 49 days for the submission of a document after Allowance. As reflected in the USPTO Transaction History, the *Notice of Allowance* was mailed on July 15, 2009, and an *Expedited Request to Correct Inventorship Under 37 C.F.R. §1.48(B) and Corrected Filing Receipt by Issued* was filed September 02, 2009. Patentee asserts and defends this action as one to overcome the Office's omission or delay in correcting the file history and bibliographic data, and to ensure correct information was published on the issued patent. As entered in the file history, and evidenced in the September 02, 2009 *Request*, a *Request to Amend the Inventorship* was originally filed in the Office on November 11, 2008, and acknowledged and accepted by Examiner Navarro in the subsequent *Office Action* issued January 29, 2009. Accordingly, Patentee respectfully requests that the September 02, 2009 *Request* not be considered a failure to engage in reasonable efforts to conclude examination of this application, and thus not accorded any APPL delay days.

REMARKS

In summary, and in consideration of the foregoing, Patentee respectfully requests correction of the calculation of Total PTA to include the **365 PTO delay** days accumulated under 35 U.S.C. §154(b)(1)(A) after June 13, 2007, (14 months from the 371 filing and commencement date of April 13, 2006,) until June 12, 2008 (1st Office Action), **minus APPL Delay of 30 days** for filing of *RCE* on May 29, 2009, after the Final Rejection Action of January 29, 2009, resulting in a **Total PTA of 335 days** instead of the 0 days erroneously accorded this patent under Patent Term Extension.

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Attorney's Docket No.: 1951326.00019
Request for Reconsideration of PTA at Issuance

PTO Delay: 365 days
APPL Delay: 30 days
Total PTA: 335 days

Patentee notes that there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of this application other than those already considered in the comments above on the projected PTO delays and APPL delays anticipated when the erroneous PTE classification is corrected, and the prosecution file history is appropriately calculated under PTA.

Patentee also respectfully requests the waiving of the \$200.00 petition fee required by 1.18(e) due to the nature of the error and in consideration of the Office's misclassification of this application, and subsequent miscalculations under Patent Term Extension (PTE) rather than Patent Term Adjustment (PTA). However, any fees that may be due in connection with the filing of this paper should be charged to Deposit Account No. 50-3207.

Respectfully submitted,

January 22, 2010
Date

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